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09/823,821	03/30/2001	Kenji Mizutani	ERDP001.I	6664

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EXAMINER

BUI, KIEU OANH T

ART UNIT PAPER NUMBER

2611

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/823,821

Applicant(s)

MIZUTANI, KENJI

Examiner

KIEU-OANH T BUI

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-82 is/are allowed.
- 6) ☒ Claim(s) 83,91-96 and 100 is/are rejected.
- 7) ☒ Claim(s) 97-99 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/30/2001</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. Claims 1-82 are allowed.
2. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 1, 47 and 62, Franco discloses “a remote video recording and retrieval system” (Fig. 7) comprising: “a first computing device having access to a tuner, to a computer network, and to a video recording mechanism, said first computing device being effective for encoding a video signal into at least one predetermined video data encoding format” (Fig. 5 for the remotely programmable video recording with a processor 522 as a first computing device having access to a tuner 504, with decryption module for video data encoding/decryption, see page 8, par. 0089 to par. 0095; and to a computer network as shown in Figure 1 for an overview of a computer network system that a user can access to the remotely programmable video recording device via a host system using the Internet); and “a second computing device having access to said first computing device via said computer network, and having access to a first data store remote from said first computing device, said second computing device being effective for submitting a user ID identifying itself and for submitting recording instructions to said first computing device for recording a televised program” (Fig. 7 shows a second computing device or a processor 706 within the client programming device 702, and from this device, the user provides user ID and the user’s commands via communication links 710 or 712 for recording instructions to record a TV program, see page 8, par. 0097 to page 9, par. 0102; and Figs. 2A & 4A for user ID is needed fro the system to authorize the access, page 5, par. 0068 & page 7, par. 0083).

Art Unit: 2611

However, Franco does not further disclose the steps of “said first computing device being effective for accessing and recording said televised program via said tuner and said video recording mechanism, said first computing device being further effective placing first visible ID stamp corresponding to said user ID on a visible section of the recorded televised program and transferring a video encoded data version of said recorded televised program to said first data store” of claim 1; same as with the step of “posting a user name corresponding to said user ID on the resultant encoded data file, and storing said resultant encoded data file in said data store” of claim 47; same as with step d for “encoding said received signals into a predetermined encode format to produce an encoded signal representation of said received signals and placing a user name corresponding to said user ID on said encoded digital representation” of claim 62.

3. Claims 97-99 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. The following is a statement of reasons for the indication of allowable subject matter:

As for claims 97-99, in addition to claims 83 AND 96, Franco does not further disclose the steps of “said first or second identifier is incorporated as a readable text section of said encoded recording”; “wherein said encoded recording is a video recording and said first or second identifier is incorporated into said encoded recording as a visible message when the recording is played”; and “wherein said encoded recording is a purely audio recording and said first or second identifier is incorporated into said encoded recording as an audible message when the recording is played” as claimed.

Art Unit: 2611

***Claim Objections***

5. Claim 83 is objected to because of the following informalities: in the conventional ordering system, the steps must be followed either in an alphabetical order or in a numerical order. It seems that step d is missing from claim 83, or the steps should be relabeled to steps a, b, c, d, e and f instead. Appropriate correction is required.

***Claim Rejections – 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

7. Claims 83-91, 93-96, and 100 are rejected under 35 U.S.C. 102(e) as being anticipated by Franco (U.S. Patent Pub No. 2002/0046407 A1).

Regarding claim 83, Franco discloses “a method of broadcast program following steps: reservation and retrieval” (Figs. 1& 7, and page 1, par. 0013) comprising the following steps:

- a) maintaining a user database of authorized users (page 6/par. 0078 for a server in collecting and building a database for users, as in par. 0071-0073);
- b) requesting user identification information from a prospective user (Fig. 2A);

Art Unit: 2611

- c) using said user database to authenticate said prospective user and not proceeding to step e unless said prospective user is authenticated as an authorized user by said identification information and said user database (Fig. 4A, step 404, and page 7, par. 0083 at the step of authentication, otherwise, the login page suggests not to grant access if the user does not provide username and password);
- e) accepting recording instructions from said authorized user, storing said recording instruction in a scheduling database, and associating said recording instructions with said authorized user (Fig. 4A, step 406 & 408, and page 7, par. 0085 & 0086);
- f) reviewing said scheduling database and instigating a recording session as determined by said scheduling database, said recording session including the encoding of a recorded broadcast program into a predetermined encode format (Figs. 2B & 2C for reviewing schedules and updates if needed);
- g) notifying said authorized user of completion of said recording session (Fig. 2C as “recorded programs” is notified to the user).

As for claim 84, Franco discloses “wherein step a further includes associating a distinct hardware ID with a plurality of electronic accessories, and not permitting access to step e unless a prospective user requests access using one of said plurality of electronic accessories having one of said distinct hardware IDs” (page 6, par. 0073 as the user’s brand, model, or configuration refers to hardware IDs is pre-setting up to the system for authentication).

Art Unit: 2611

As for claim 85, Franco suggests “wherein step a further includes correlating each of said electronic accessories with a corresponding authorized user in said user database, and step c further does not proceed to step e if said authorized user does not use its correlated electronic accessory when requesting access”, i.e., the host system comprising a server and generating a programming database based on the user’s inputs or commands for authentication, requests for remote recording etc. and using hardware identification as in claim 84 above; therefore, unauthorized users can not access or allow to access to the system as also shown in Fig. 2A, and step c in claim 83 above.

As for claim 86, Franco shows “wherein said electronic accessory is selected from a list including a computer daughter board and an electronic ID key device externally attachable to a computing device” (Fig. 7 for item 704 -a client communication module- as a computer daughter board, which can be attached to the device; and electronic ID key device attached externally, known in the art for identifying parts and devices, as model ID attached to the device, page 6/par. 0073).

As for claims 87 and 88, Franco discloses “wherein step e further includes accepting an encode format selection” and “wherein said encode format selection is said predetermined encode format of step f” (page 1/par. 0010; and page 10/par. 0110 for an encryption format or CDTL encoded format).

As for claim 89, Franco discloses “wherein step f further includes comparing said predetermined encode format with said accepted format selection and converting said predetermined encode format to said accepted format selection when they are not the same” (Figs. 10-11, and page 10/par. 0113 to page 11/par. 0127 for the process of encryption and

Art Unit: 2611

decryption according to the content broadcasting from the broadcaster 1010 using content decryption key 1002).

As for claim 90, Franco discloses “wherein said accepted encode format selection is one of an audio recording and video recording data encode format” (Fig. 2C, and page 2/par. 0015 for video and audio recording encoded format).

As for claim 91, Franco suggests further “including: maintaining a broadcast format database correlating the default broadcast format for different geographic locations; step e further includes accepting information regarding the geographic location of said authenticated user, determining if the default broadcast format of the program to be recorded is the same as the broadcast format correlating to the authenticated user's accepted geographic location, and if they are not the same requiring that step f include the step of converting the recorded program to the default broadcast program associated with the authenticated user's accepted geographic location”, i.e., broadcast contents can be adapted to the user's location or geographic location, as the user can request for this feature (page 6/par. 0071).

As for claim 93, Franco discloses further “including: maintaining a broadcast format database correlating the default broadcast format for different geographic locations; step e further includes accepting a selected broadcast format from said authenticated user, determining if the default broadcast format of the program to be recorded is the same as said selected broadcast format, and if they are not the same requiring that step f include the step of converting the recorded program to said selected broadcast format” (see claims 89-91 above).



Art Unit: 2611

As for claims 94-95, these claims for “wherein step e further includes providing a list of geographic regions and accepting a selected geographic region from said list, providing a listing of broadcast programs available for recording within said selected geographic region” and “wherein the recording session of step f is conducted within said selected geographic region”, i.e., broadcast contents can be adapted to the user’s location or geographic location, as the user can request for this feature (page 6/par. 0071; and Figs. 2B & 2C for a list of programs selected according to the predefined region or locality as noted).

As for claim 96, Franco shows “wherein step f further includes incorporating at least one of a first identifier of said authenticate user and a second identifier showing at least part of said accepted recording instructions in the encoded recording” (Fig. 4A for identifying and accepting the user ID, and accepting recording instructions from the user at steps 406 & 408).

As for claim 100, Franco shows “wherein step g further includes transmitting the recording to said authenticated user as a data file” (as shown in Figs. 2b & 2C, the data is transmitted to the host computer system and the remote recording system in a data file or web pages, as in Fig. 14, and page 5/par. 0064 for CDTL data files).

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

Art Unit: 2611

9. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Franco (U.S. Patent Pub No. 2002/0046407 A1).

Regarding claim 92, Franco does not mention “wherein said broadcast format database includes at least geographic locations correlating to the use of PAL and NTSC default broadcast formats”; however, the Examiner takes an official notice that this is well-known in the art that the broadcasters can use of PAL and NTSC broadcast formats as default formats for video and television transmission/broadcasting. PAL was widely used in the Europe and NTSC is commonly used in the US for TV and video signal transmission. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Franco’s system with well-known PAL and NTSC standard format in order to provide broadcasting services using these default formats for video and audio signal transmissions.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Allen (US Pat. No.5,909,638) discloses a high speed video distribution and manufacturing system.

Hesselink et al. (US Pat. No.6,732,158 B1) disclose a VCR webification.

Ogasawara (US Pat. No. 6,543,052 B1) discloses an internet shopping system utilizing set top box and voice recognition.

Terakado et al. (US Pat. No. 6,802,076 B1) disclose a method and apparatus of an electric transmission medium.

Art Unit: 2611

Kenner et al. (US Pat. No. 5,956,716) disclose a system and method for delivery of video data over a computer network.

**11. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9306, (for Technology Center 2600 only)**

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).*

**12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant, can be reached on (571) 272-7294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Krista Bui  
Primary Examiner  
Art Unit 2611

KB  
April 1, 2005